

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) H0006930-1161.1163101			
I hereby certify that this correspondence is being deposited by facsimile with the United States Postal Service or with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>2008-09-29</u> Signature <u>/lynn thompson/</u> Typed or printed name <u>Lynn Thompson</u>		Application Number 10822882 First Named Inventor Richard Simmons Art Unit 2863	Filed 2004-04-13 Examiner Aditya S. Bhat		
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. <input checked="" type="checkbox"/>					
This request is being filed with a notice of appeal. <input checked="" type="checkbox"/>					
The review is requested for the reason(s) stated on the attached sheet(s). <input checked="" type="checkbox"/> Note: No more than five (5) pages may be provided.					
I am the <table style="width: 100%; border: none;"> <tr> <td style="width: 50%; vertical-align: top;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38638</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </td> <td style="width: 50%; vertical-align: top;"> <u>/brian n. tufte/</u> Signature Brian N. Tufte Typed or printed name <u>612.677.9050</u> Telephone number <u>2008-09-29</u> Date </td> </tr> </table>				<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38638</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>/brian n. tufte/</u> Signature Brian N. Tufte Typed or printed name <u>612.677.9050</u> Telephone number <u>2008-09-29</u> Date
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.					
<input type="checkbox"/> *Total of _____ forms are submitted.					

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Richard Simons

Examiner: Aditya S. Bhat

Serial No. 10/822,882

Group Art Unit: 2863

Filed: April 13, 2004

Confirmation No.: 4002

For: REMOTE TESTING OF HVAC SYSTEMS

Docket No.: H006930-1161.1163101

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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I hereby certify that this paper is being electronically transmitted to the United States Patent and Trademark Office on the date shown below.


Lynn Thompson

September 29, 2008
Date

Applicants submit that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a prima facie rejection.

Independent claims 39 and 43 are rejected as being anticipated by Hill et al. The Examiner appears to be equating Hill's step of using "entry device 10 to access diagnostic or status information relating to HVAC device 14" (Emphasis Added; see column 2, lines 59-60), or "querying the at least one HVAC device for status information on a regular basis or when requested by a message from the entry device" (Emphasis Added; see column 2, lines 19-22) with the steps recited in claims 39 and 43. This is clearly in error. MPEP § 2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (Emphasis Added).

Hill's step of accessing information clearly cannot be deemed to be identical to the steps recited in claims 39 and 43. While claims are given the broadest reasonable interpretation, MPEP § 2111 also states that the broadest reasonable interpretation must be "consistent with the specification" and "must also be consistent with the interpretation that those skilled in the art

would reach". Applicants submit that equating the information accessing or querying steps of Hill with the steps of transmitting a test request, and performing one or more tests in response to the test request, as recited in claim 39, is not a reasonable interpretation. Hill's status information accessing steps are also not identical to the steps of transmitting one or more maintenance signals, and performing a self-test based on the received one or more maintenance signal, as recited in claim 43. Hill appears to merely teach accessing pre-existing status information on an HVAC system from a remote location. One of ordinary skill in the art would not equate such a step with the claimed steps of actively transmitting a test request or maintenance signal, and in response, performing a test. The Examiner's interpretation of the claims is inconsistent with the specification and is inconsistent with the interpretation that would be reached by one of ordinary skill in the art.

Additionally, the Examiner has given no reasoning or support for the interpretation that accessing existing diagnostic or status information in response to a user's entry through the entry device of Hill can somehow be equated with the specific method steps recited in independent claims 39 and 43. The Examiner merely states "[t]he pending claims are believed to read on the prior art of record and the rejection is deemed proper," without providing any support for the belief that a step of accessing information is the identical step of transmitting a test request or maintenance signal, and in response, performing a test. For these and other reasons, Hill cannot be deemed to anticipate claims 39 and 43.

Moreover, and specifically with respect to claim 43, nowhere do Hill et al. appear to teach or suggest receiving the one or more maintenance signals at each of the HVAC systems, the one or more maintenance signals activating an HVAC component, performing a self-test on the activated HVAC component based on the received one or more maintenance signal, generating self-test result signals from the activated HVAC component based on the self-test performed on the activated HVAC component, as well as the other elements of claim 43.

Applicants note that the claims are directed to methods, and that an anticipation rejection requires that all of the method steps be found in the prior art. It appears that the Examiner might be asserting that the system of Hill could somehow be modified to perform the claimed methods,

which is not a proper basis for anticipation. The Examiner has failed to provide a reference teaching the identical invention shown in as complete detail as contained in the claims, as is required to support an anticipation rejection. The anticipation rejection of claims 39-40 and 42-45 is thus in error and should be withdrawn.

Regarding independent claim 1, the Examiner asserts the AndelmanLelek reference teaches testing a dormant component of an HVAC system and asserts that it would have been obvious to modify the methods of Hill to include off season testing to ensure the HVAC system was functioning properly before the season change to minimize/eliminate service interruption. Applicants respectfully disagree. It is noted that the Examiner's reason for combining Hill and AndelmanLelek comes from Applicant's own specification, which is believed to be clearly improper.

Moreover, the Examiner appears to have misinterpreted the AndelmanLelek reference. AndelmanLelek actually appears to teach in-season testing. The Seasonal Testing paragraph in AndelmanLelek calls for testing portions of systems that are weather dependent during the opposite season that they were originally installed, where the installation takes place during the "off" season. More specifically, AndelmanLelek states, "[i]f an air handling unit was commissioned during the summer a follow-up test would be performed during the winter for items such as the heating valve and damper controls." (Emphasis Added). AndelmanLelek thus appears to teach testing the heating system in the winter, which is opposite to the method steps recited in claim 1. More specifically, AndelmanLelek appears to teach that when a heating system is commissioned in the summer, the contractor must come back to test the heating system in the winter (i.e. during the in-season) to verify stability of control.

Moreover, AndelmanLelek does not appear to teach sending or receiving a test request and performing a test in response to the test request, but merely notes that when a heating system is installed in summer, the contractor must return to test the heating system in the winter to verify stability of control. Notably, the Seasonal Testing paragraph of AndelmanLelek does not relate to on-going maintenance of the installed systems, but rather relates to the initial commissioning of the system. In addition, nowhere does AndelmanLelek appear to teach, disclose, or suggest

receiving a test request from a remote location; performing a test on a dormant component of the HVAC system in response to the test request, and transmitting the test result to a location outside of the building structure for subsequent analysis, as recited in claim 1. As can be clearly seen, neither Hill nor AndelmanLelek teach or suggest many of the elements of claim 1. Additionally, the Examiner has failed to provide any reasoning as to why it would be obvious to modify Hill to perform a test on the dormant component of the HVAC system in response to a test request provided from a remote location to arrive at claim 1, particularly in view of the teaching in AndelmanLelek of having an HVAC contractor physically return in the winter (i.e. during the in-season) to test portions of the heating system that was installed in the summer.

Regarding independent claims 29 and 30, the Examiner asserts that since AndelmanLelek teach retesting HVAC components in the opposite season from when they are installed, “clearly they were tested in the season they were not required.” Applicants respectfully disagree. As discussed above, AndelmanLelek appear to teach installing a heater in the summer, and having the contractor return in the winter for in-season testing of the heater for stability and control. At best, AndelmanLelek might suggest installing and commissioning a heater in the summer, with the so-called “off-season” testing being relate to the basic setup and testing that would be performed by the on-site contractor during initial installation. However, such summer testing would clearly be performed by the contractor during installation (i.e. when the contractor is already on site), and thus there would be no reason or motivation whatsoever for a contractor to send a test request from a remote location, and in response, have the system perform a test as recited in claims 29-30. Not only does the recited combination not result in the specific methods recited in claims 29-30, but it does not even make sense since the installer would have ready on-site access to the status information during the initial installation process.

As can readily be seen, the Examiner has failed to provide references that teach or suggest many of the elements of the claims, and has not provided the required articulate reasoning to support the conclusion of obviousness. The rejection is thus in error.

Turning now to claim 35, and as discussed above, nowhere do Hill or AndelmanLelek, taken alone or in combination, teach or suggest transmitting a test request to each of the plurality

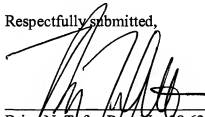
Application Serial No. 10/822,882
Response to Final Office Action dated August 1, 2008

of HVAC systems from the remote location, performing one or more tests on each of the HVAC systems in response to the test request, and producing a test result for each of the HVAC systems, wherein at least one of the one or more tests that is performed activates and tests one or more of the active or dormant components of an HVAC system, transmitting the test result for each of the HVAC systems to a remote location, and storing the test results at the remote location. While Hill appear to teach remotely accessing status information regarding an HVAC system, and AndelmanLelek appear to teach having a contractor return and test a heater during the winter (i.e. in-season) when the heater was installed in the summer, neither reference nor their combination teach the specific method steps of claim 35 including the steps of transmitting a test request from a remote location, and performing a test on an HVAC component in response to the test request. The Examiner has thus failed to provide references that teach or suggest each and every elements of claim 35, and has not provided articulate reasoning to support the conclusion of obviousness.

For additional remarks, the panel is invited to reference Applicant's Amendment filed June 12, 2008, which is incorporated herein by reference.

For the foregoing reasons, the rejection of claims 1-20, 29-30, 35-38, and 41 is clearly in error. Withdrawal of the rejections is respectfully requested.

Respectfully submitted,



Dated: September 29, 2008

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